

REMARKS

Currently claims 1-24 are pending in the application. The Examiner, in the Official Action, has provided new grounds of rejection and in particular has rejected claims 1-8, 12-20 and 24 under 35 USC § 103(a) as being unpatentable over Jebens et al. and Allen et al. in view of Cromer et al. for the reasons set forth in paragraph 4.

In the present invention of independent claims 1, 12 and 24 there is provided an automatic service over a communication network with regard to stored instructions on a user computer. In particular, there is provided automatic initiating the obtainment of instructions stored on a user computer over a communication network by a service provider. The instructions that are stored on the user computer are associated with digital media file that is also stored on the user computer. The claim method and system of the present invention further includes the steps of implementing the instructions with respect to the associated digital file that is stored on the user computer.

The Examiner has cited column 3, lines 5-10 of Jebens of teaching the automatic initiating of obtaining instructions stored on a user computer. However, Applicant would like to point out that the passage to which the Examiner refers to at column 3, lines 5-10 is directed to the situation where instructions are provided by the user 12 that provide instructions for a host 10 for delivering of files to an identified second user such as supplier 16. See column 21, lines 62-67 and column 22, lines 36-42. It can be clearly seen that it is the user that initiates the order to the host site 10 whereupon the host site would then, in response, prepare a job order and sends it to the appropriate recipient.

With regard to column 18, line 63 to column 19, line 10 of Jebens, this portion of the specification is dealing with submitting of images from the image provider 14 to the host site 10. In this situation it is the image provider computer that initiates the actions required for sending of the images to the host site. In particular see column 18, line 66 to column 19, line 1 which states "The communication portion of the local computer then establishes a connection with the host site 10 or other destination by automatically dialing or sending a network request". As can be clearly seen it is the image provider computer that initiates the communication. In the present claimed invention, it is the service provider

that initiates the action and obtains the instructions stored on the local computer. Then, in the present invention the service provider in response to the instructions stored on the local computer, takes the appropriate action with regard to the digital image file stored on the local computer, i.e. user computer. This is not taught or suggested in Jebens. The hot folder system in Jebens is simply a system for allowing the transmission of images from one place to another. Jebens reference does not teach or suggest the automatic obtaining and reading of instructions on the local computer that is initiated by the service provider as taught and claimed by Applicant.

With regard to the Allen et al. reference, this reference is directed to a digital camera that can transmit images to a third party and along with instructions. However, the Allen et al. reference teaches that the camera initiates the communication. This is in complete contradiction to the claimed invention in that the claimed invention requires the initiation by the host, i.e. service provider, computer. This is clearly not taught or suggested. In fact, the Allen reference teaches away from such action. Furthermore, there is no teaching or suggestion or motivation as to why one would combine the teachings of Allen et al. with the Jebens et al. reference. As set forth by the CAFC *In re Lee* 277 Fed 3rd 1338 (61 USPQ 2nd 1430 at page 1433) 2002

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness ... factual inquiry whether to combine references must be thorough and searching ... It must be based on objective evidence of record ... teachings of references can be combined only if there is some suggestion or incentive to do so.”

In the cited references the Jebens is directed to an image management system where a host site manages stored images. This is in contrast to the Allen et al. reference which is directed to a system for transmitting digital images from a digital camera to an image fulfillment server which receives the images and acts in accordance with instructions provided therewith. The Jebens reference is directed to a digital data management system and order delivery system whereas the Allen et al. reference is directed to a digital camera that transmits images and instructions to a fulfillment provider. In particular, the

providing and use of voice commands of the photographer for transmitting image fulfillment instructions. There is no motivation or suggestion of combining the references as suggested by the Examiner. Further, in neither reference does it teach or suggest the automatic initiating of obtaining instructions stored on a user computer from a remote site as taught and claimed by Applicant. Thus, even if the two cited references were combined, it would simply disclose using voice commands with a digital camera that is to be implemented by a service provider. However, the host system of the Jebens et al. reference is not a fulfillment provider but merely a management system that forwards information on to other suppliers. Thus, the two are directed to two totally apart and distinct type of systems and there would be no motivation or suggestion to combine one with the other. Further, even if the references were combined, they would still fail to teach or suggest the claimed invention for the reasons previously set forth.

With regard to the Cromer et al. reference, it is respectfully submitted that this reference is directed to a data processing system and method totally apart from that of the claimed invention. In particular, the data processing system in the Cromer et al. discloses remotely accessing of information from a computer that is shut down through the use of an adapter 230. As set forth at column 3, lines 30-33 and column 4, lines 48-52 it is clear that there is provided a network adapter that is associated with the client computer that allows access to stored assets on the computer. As set forth at column 5, lines 8-12, a wake-up signal is produced by the network adapter to wake up client computer. Clearly the Cromer et al. reference is directed to a system totally apart and distinct from the present invention in that it requires an adapter associated with the client computer for allowing access to assets thereon. There is no teaching or suggestion in the Cromer et al. reference of obtaining instructions and implementing the instructions with regard to stored image data stored thereon. Nor is there any motivation or suggestion to combine the cited references as suggested by the Examiner. Accordingly, it is respectfully submitted that the three cited references do not teach or suggest the invention as taught and claimed by Applicant.

With regard to claims 2 and 14, Applicant respectfully submits that the cited reference at column 9, lines 47-51 of Jebens does not teach or suggest the sale of rights to reproduce the images as taught and claimed by Applicant.

The passage quoted by the Examiner is just to determine the type of data that has been submitted and how it is to be filed. There is no teaching or suggestion with regard to sale of "rights" to use and/or reproduce the image that has been submitted.

With regard to claims 5 and 17, the passage cited by the Examiner is directed simply to the format in which the results of a search is displayed to a user. It does not discuss the providing of a form where instructions have been added as set forth and required by claims 5 and 17.

The remaining claims depend at least ultimately upon the independent claims which Applicant respectfully submits are patentably distinct over the cited art. Accordingly, these dependent claims are also patentably distinct.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Frank Pincelli", written in dark ink.

Attorney for Applicant(s)

Registration No. 27,370

Frank Pincelli/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.